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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,058	09/19/2003	Stefan J. Rublowsky	PRKR-4500	7284
7590 03/22/2007 Philip A. Girard GIRARD & EQUITZ LLP Suite 1110 400 Montgomery Street San Francisco, CA 94104			EXAMINER LONEY, DONALD J	
			ART UNIT 1772	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		03/22/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/668,058

Applicant(s)

RUBLOWSKY ET AL.

Examiner

Donald Loney

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,4,6-10,12,14 and 19-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2,4,6-10,12,14,19-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 2, 4, 6, 7, 8 and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Giulie (4471976).

Giulie teaches a binder strip 12 containing a substrate 19,23 that has a heat activated adhesive 14 thereon. The adhesive has what can be considered grooves where valleys 17 are formed therein (i.e. the section between peaks 16). The grooves appear, from the figures, to be more than 20% the thickness of the adhesive. Refer to figures 1, 3 and 4 along with column 2, lines 27-42. The adhesive extends intermediate the opposite parallel edges on each side of the substrate (i.e. the right and left side). The recitations as to elongated and length per claims 2 and 4 respectively are relative terms which do not structurally distinguish the claimed invention from the prior art. The claims fail to recite one of the axis, or lengths, is longer than the other. Regarding claim 36, a "significant" amount of adhesive is considered not removed and the claims fail to structurally distinguish from the prior art due to this relative term "significant", since no specific matter of degree is recited.

3. Claims 2, 4, 6, 7, 8, 9, 12, 14, 19-21 and 36-38 are rejected under 35 U.S.C. 102(b) as being anticipated by DuCorday (4800110).

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DuCorday also teaches an elongated strip (spine section 16 of 10) containing a substrate with a heat activated adhesive 26 thereon that contains grooves 34,36 (i.e. deformities). The grooves appear, from the figures, to be more than 20% the thickness of the adhesive. This rejection is being made to specifically address the limitation that the grooves run the length of the strip. The grooves run parallel to the longitudinal axis of intermediate spine section 16. The applicant, due to the use of the open claim language to 'comprising', is not excluding any other section of the strip. It can be seen from applicants' figures 4 and 6a-6C that the prior arts adhesive runs the same direction along the binding. The opposite side of the substrate is substantially smooth in at least some second surface regions per claims 6 and 22. Regarding claims 36-38 a "significant" amount of adhesive is considered not removed and the claims fail to structurally distinguish from the prior art due to this relative term "significant", since no specific matter of degree is recited. With respect to the product by process claims 2, 4, 12, 14, 18, 20 and 22, it must be emphasized that it is the patentability of the product that is in issue not the patentability of the process steps employed to prepare the product. See *In re Fessmann*, 180 USPQ 324 and *In re Brown*, 173 USPQ 685. The prior art contains the same structure as recited for the product.

4. Claims 2, 4, 6, 7, 10, 12, 14, 20-23, 26-29, 33 and 34-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Wang et al (4371195).

Wang et al discloses a bonder strip comprising a substrate 19 and a hot-melt adhesive 21,23,24 containing grooves 23b,24b (i.e. mechanical deformalities in the surface of the adhesive). Refer to figure 1 along with column 3, lines 36-64. The

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adhesive runs the entire length of the strip from top to bottom and is used to connect pages thereto. The deformalities are also disclosed as adding in the adhesive from cold folding and the tendency to spring back are small (i.e. adding in curling thereof). Refer to column 2, lines 26-30. Regarding claims 36-38, a "significant" amount of adhesive is considered not removed and the claims fail to structurally distinguish from the prior art due to this relative term "significant", since no specific matter of degree is recited. With regards to the substrate being smooth opposite the adhesive, in at least figure 9, the substrates score lines 223 and 224 are not opposite the portion where at least a portion 21 of the adhesive is located.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 10 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over DuCorday in view of Pogrzeba et al (4247273) or Liland et al (4612230).

The primary references teach the invention substantially as recited except for the deformities to be punctures. Refer to the 35 USC 102 rejections above. The applicant discusses the punctures, on page 11 of the specification, as being formed using an awl, which would form an indent in the adhesive.

Pogrzebra et al teaches that either grooves or indents (punctures as described above) can be formed in a layer in order to prevent a "winged effect" (i.e. curling). This deforming leads to a greater stability in shape of the layer. This is the same reason the applicant is deforming the adhesive layer (i.e. to reduce curl). Refer to figures 3a and 3b along with column 2, lines 41-52. Liland et al discloses punctures 15 formed in the substrate portion of an adhesive tape in order to reduce curl. Refer to figure s 1-3 along with column 2, lines 14-18.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to the DuCorday to form the deformities of a puncture shape, as taught by the secondary references, in order to provide greater stability to the layer by preventing curl of the layer motivated by the fact the secondary references teach the deformities reduce curl.

7. Claims 22-28, 30-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over DuCorday in view of Wang et al.

The primary reference teaches the invention substantially as recited except for all of the second surface of the substrate being smooth per claims 22, 27, 28, 30, 31, 34 and 35. See the 35 U.S.C. 102 rejection above.

Wang et al teaches the second surface of the substrate in a binder strip being smooth. Refer to the surface of substrate 17 opposite the adhesive 21, 23, 24 in figures 1-3.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to DuCorday to form the second surface of the substrate

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smooth, as taught by Wang et al, motivated by the fact that it has been held within the general skill of a worker in the art to eliminate an element or its function (i.e. the grooves that aid in bending in DuCorday) as a matter of obvious engineering choice. See In re Karlson, 136 USPQ 183 (CCPA 1963).

8. Claims 2, 4, 6-10, 12, 14 and 19-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over the applicant's discussion of the prior art (ADPA) in view of either Pogrzeba et al (4247273) or Liland et al (4612230).

The ADPA discloses that binder strips comprising a substrate and hot-melt adhesive are known in the art and that the applicant's invention is in deforming the adhesive in order to prevent curl therein.

Pogrzebra et al teaches that either grooves or indents (punctures as described above) can be formed in a layer in order to prevent a "winged effect" (i.e. curling). This deforming leads to a greater stability in shape of the layer. This is the same reason the applicant is deforming the adhesive layer (i.e. to reduce curl). Refer to figures 3a and 3b along with column 2, lines 41-52. Liland et al discloses punctures 15 formed in the substrate portion of an adhesive tape in order to reduce curl. Refer to figures 1-3 along with column 2, lines 14-18.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to the ADPA to form the deformities in the surface of the adhesive, in order to provide greater stability to the layer by preventing curl of the layer motivated by the fact the secondary references teach the deformities reduce curl.

Response to Arguments

9. Applicant's arguments filed March 16, 2006 have been fully considered but they are not persuasive. The applicant argues that the examiner is disregarding the process limitations and sequence of steps used to form the product. The examiner has taken this in to account. The structure implied thereby in the claims is a strip comprising a hot-melt adhesive containing deformalities (i.e. specifically grooves and/or punctures), of which is structurally shown in the prior art. With regards to all the independent claims, of which are in product by process format, it must be emphasized that it is the patentability of the product that is in issue not the patentability of the process steps employed to prepare the product. See *In re Fessmann*, 180 USPQ 324 and *In re Brown*, 173 USPQ 685. See MPEP section 2113. The applicant argues that all of Giule, DuCorday and Wang are believed to teach the adhesive having the deformalities formed when the adhesive is hot, versus the adhesive being in the cool state as recited. Again, it must be emphasized that it is the patentability of the product that is in issue not the patentability of the process steps employed to prepare the product. See *In re Fessmann*, 180 USPQ 324 and *In re Brown*, 173 USPQ 685. See MPEP 2113. The applicant argues that both DuCorday and Wang fail to teach the substrate as being smooth opposite the adhesive layer. The claims drawn to the smoothness have been withdrawn from the DuCorday rejection, but have been included in the Wang rejection as discussed above. The applicant has not put forth any argument's as to the rejection over the applicant's discussion of the prior art (ADPA) in view of either Pogrzeba et al (4247273) or Liland et al (4612230).

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10. The Declaration under 37 CFR 1.132 filed December 4, 2006 is insufficient to overcome the rejection of claims 2,4,6-10,12,14 and 19-38 based upon Guile, DuCorday or Wang as set forth in the last Office action because: It fails to show any specific matter of degree of curl, and corresponding limitations in the claims which would distinguish from the prior art. The declaration states category b) had not significant reduction while category c) had substantial reduction. No specific matter of degrees are shown to distinguish these relative terms of "significant and substantially". Additionally, the declaration is not commensurate in scope for claim 19 since it does not recite anything about reduced curl. The declaration also states the prior art forms the deformalities while the adhesive is molten, however, none of the prior art specifically discloses this is when the deformalities are formed. The applicant only states, or assumes, this is when they are formed.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

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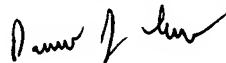
shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Loney whose telephone number is (571) 272-1493. The examiner can normally be reached on Mon, Tues, Thurs and Fri. 8AM-4PM, flex schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DJL:D.Loney
03/17/06


Donald Loney
Primary Examiner
Art Unit 1772